

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In Re Application of:

Patricia S. Kruse

Group Art Unit: 2625

Serial No.: 09/929,430

Examiner: M. Milia

Filed: August 13, 2001

Docket No. 10010789-1

For: Presentation Print Job Profiling

REPLY BRIEF RESPONSIVE TO EXAMINER'S ANSWER

Mail Stop: Appeal Brief-Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450

Sir:

The Examiner's Answer mailed October 31, 2007 has been carefully considered.

In response thereto, please consider the following remarks.

AUTHORIZATION TO DEBIT ACCOUNT

It is not believed that extensions of time or fees for net addition of claims are required, beyond those which may otherwise be provided for in documents accompanying this paper. However, in the event that additional extensions of time are necessary to allow consideration of this paper, such extensions are hereby petitioned under 37 C.F.R. § 1.136(a), and any fees required therefor (including fees for net addition of claims) are hereby authorized to be charged to deposit account no. 08-2025.

REMARKS

The Examiner has provided in the Examiner's Answer various responses to points made in Applicant's Appeal Brief. Applicant addresses those responses in the following.

1. No Teaching of Specifying Individual "Packaging Characteristics"

As discussed in Applicant's Appeal Brief, Applicant's claim 1 recites the actions of, in association with files of a presentation profile, both "specifying a set of individual printing characteristics with respect to each of the files" and "specifying a set of individual packaging characteristics with respect to each of the files". The Examiner maintains his position that Salgado discloses the claimed specifying of individual packaging characteristics. This simply is not true.

Salgado discloses a "build job technique" in which a multi-segment print job is assembled by an operator. As described by Salgado in column 5, such assembly comprises specifying various characteristics of the job:

. . . the multi-segment print job is assembled by an operator at any user interface on the network from multiple local and remote sources by identifying print job segments and location of segments on the network. This is accomplished by entering a start build print job function at the network interface, *identifying each segment of the print job including segment location, specifying print job characteristics such as paper stock and quality for each segment*, and entering an end build print job function at the network interface. Finally, *there is identified a printing device on the network and suitable features relating to the entire document such as quantity* are provided in order that each segment of the print job is

accessed and distributed to the printing device to complete the multi-segment print job.

Salgado, column 5, lines 40-54 (emphasis added). From the above excerpt, it is clear that, while Salgado discloses identification of printing characteristics such as “paper stock and quality” as to each segment of the print job, characteristics such as “quantity” are identified in relation to “the entire document”. Therefore, although Salgado teaches selection of *printing* characteristics (e.g., paper type, print quality) on a segment-by-segment basis, Salgado teaches selection of *packaging* characteristics (e.g., quantity) on a global basis. It logically follows then that Salgado does not in fact teach “specifying a set of individual packaging characteristics with respect to each of the files”.

Turning to the Examiner's Answer, the Examiner's argues on page 9 that “quantity, i.e. number of copies, is a packaging characteristic.” Applicant agrees that quantity can in one sense be considered to be a packaging characteristic. As noted above, however, Salgado explicitly states that “quantity” is a characteristic that applies “to the entire document” rather than an individual segment. Therefore, even assuming that quantity is a packaging characteristic, Salgado still fails to teach applying individual packaging characteristics to individual files.

Regarding the Examiner's argument that Salgado teaches different segments of the print job being performed by different devices, Applicant notes that, even if true, such a teaching does not inherently require specification of individual packaging characteristics with respect to each of the segments. Specifically, there is nothing within the Salgado disclosure that necessitates such specification. Instead, the

Examiner merely presumes that such specification is inherent in different devices processing different segments of the print job. Applicant further notes that just because it *may have been possible* to configure Salgado's system to enable specification of individual packaging characteristics as to each segment does not mean that such functionality is inherent. As described by the Federal Circuit:

Inherency may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient to establish inherency. *See Continental Can Co. v. Monsanto Co.*, 948 F.2d 1264, 1269, 20 USPQ2d 1746, 1749 (Fed. Cir. 1991).

Scaltech Inc. v. Retec/Tetra, L.L.C., 178 F.3d 1378, 51 USPQ2d 1055 (Fed. Cir. 1999), *Revising*, 156 F.3d 1193, 48 USPQ2d 1037 (Fed. Cir. 1998). Furthermore, the Federal Circuit has noted:

Under the principles of inherency, if the prior art necessarily functions in accordance with, or includes, the claimed limitations, it anticipates.

Atlas Powder Co. v. Ireco Inc., 190 F.3d 1342, 51 USPQ2d 1943 (Fed. Cir. 1999) (emphasis added). Given that Salgado's system does not "necessarily function" to enable specification of packaging characteristics on a segment-by-segment basis, such specification is not inherent in the Salgado reference.

As a further matter, Applicant reiterates that Applicant independently recites the actions of both "specifying a set of individual printing characteristics with respect to each of the files" and "specifying a set of individual packaging characteristics with

respect to each of the files". Given that such actions are recited independently, it follows that they are different actions and, therefore, "printing characteristics" are different from "packaging characteristics". For a proper rejection of claim 1 under 35 U.S.C. § 102, the applied reference must both teach specification of printing characteristic *and* packaging characteristics on a file-by-file (or segment-by-segment) basis. While Salgado may be said to teach specification of printing characteristics of individual files, the Examiner cannot rely upon that teaching as simultaneously accounting for the separately claimed action of specifying packaging characteristics.

Applicant notes that although the above discussions have focused on independent claim 1 and its recitations, the discussions apply equally to independent claims 9, 17, and, 25, which contain similar recitations.

2. No Legitimate Reason to Combine Salgado and Kanerva

As described in the Appeal Brief, a person having ordinary skill in the art would not think to modifying the Salgado system with the teachings of Kanerva given that doing so would interfere with a basic premise upon which the Salgado system is based. Generally speaking, it is Salgado's goal to enable the construction of a print job from a central point of control even when the various components (i.e., "segments") of the print job may be scattered over various devices of a network. *See e.g. Salgado*, column 2, lines 31-35. To accomplish that goal, Salgado's proposes a "user interface 40" at a single device (e.g., workstation, printer, or scanner) that can be used to "build" the print job. Kanerva, on the other hand, teaches an opposite arrangement in which control over a print job is spread out among different programs. Specifically, rather than

consolidating control within a single program, such as Salgado's user interface 40, Kanerva teaches reliance upon different application programs to provide such control. Integration of such dispersed control into Salgado's system would therefore contradict Salgado's goal of consolidated control.

3. No Teaching of Identifying "Subsets" of Files

As indicated in the Appeal Brief, Hicks does not, as is alleged by the Examiner, disclose identifying different subsets of files of a presentation profile. Instead, Hicks discloses identification of *different portions of a single document*. Given that fact, it is clear that there is no teaching or suggestion provided by the Hicks reference for "identifying a first subset of the files that are to be included in the presentation package and a second subset of the files that are to be included in a general distribution package, wherein the second subset of files is different than the first subset of files" as recited in claim 3 (similar recitations contained in claims 11, 19, and 27) or "identifying a subset of files that are to be included in a general distribution package" and "indicating a number of copies to print with respect to the subset of the files that are to be included in the general distribution package" as recited in claim 5 (similar recitations contained in claims 13, 21, and 29).

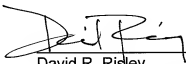
In reply to the Examiner's allegation that Hicks teaches identification of different subsets of a presentation profile in "column 7 line 10-column 11 line 6", Applicant notes that if Hicks actually contained such a teaching, the Examiner would have been able to identify it with greater particularity. Specifically, the Examiner would have been able to identify the few individual lines of text that describe that aspect of Applicant's claims

instead of vaguely referring to four (4) whole columns of the Hicks disclosure. Applicant has reviewed those columns and can find no teaching of identifying different subsets of files of a presentation profile.

CONCLUSION

In summary, it is Applicant's position that Applicant's claims are patentable over the applied prior art references and that the rejection of these claims should be withdrawn. Appellant therefore respectfully requests that the Board of Appeals overturn the Examiner's rejection and allow Applicant's pending claims.

Respectfully submitted,



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